

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN RIZZOTTO and EUGENE KARDELIS JR.

Appeal No. 2005-2436
Application No. 09/827,686

ON BRIEF

Before KIMLIN, GARRIS and KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 4-9, 18 and 22-26. Claim 1 is illustrative:

1. A chewable flavor delivery system comprising in combination:

a carrier consisting of an edible cellulosic plant material being 100% cabbage leaves prepared by one of, forming into strands or in granular form dried to a moisture content of at or below 8% by weight, said cabbage leaves having at least 30% intact cell walls;

a water soluble but not water containing flavoring ingredient in liquid form and capable of entering intact cell walls of said cabbage leaves; and

an effective amount of a food safe humectant.

In the rejection of the appealed claims, the examiner relies upon the following references:

Garber	2,331,830	Oct. 12, 1943
Finberg	3,067,068	Dec. 4, 1962
Rozacky et al. (Rozacky)	3,702,615	Nov. 14, 1972
Aebi et al. (Aebi)	5,368,873	Nov. 29, 1994
Nonomura et al. (Nonomura)	5,597,400	Jan. 28, 1997

Appellants' claimed invention is directed to a chewable flavor delivery system comprising a carrier of 100% cabbage leaves, a water soluble flavoring ingredient in liquid form, and a food safe humectant. The cabbage leaves have a moisture content at or below 8% by weight and have at least 30% intact cell walls.

Appealed claims 1, 4-8, 18, 24 and 25 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Finberg. Claims 1, 4-6, 8, 18, 23 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Aebi. In addition, the claims stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 4-6, 22 and 23 over Finberg in view of Garber;
- (b) claims 9 and 26 over Aebi in view of Nonomura;
- (c) claims 1 and 4-8 over Rozacky; and
- (d) claim 9 over Rozacky in view of Nonomura.

Appellants submit that "[c]laims 1, 4-6 and 9 stand as one embodiment of the invention," and that "[c]laims 18, 22-23 and 26 stand as a second embodiment of the invention" (page 6 of principal brief). However, the Argument section of appellants' brief fails to set forth an argument that is reasonably specific to any particular claim on appeal. Accordingly, the groups of claims separately rejected by the examiner stand or fall together. For instance, the separate § 102/§ 103 rejections over Finberg and Aebi stand or fall together with claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner's reasoned analysis and application of the prior art, as well as her cogent disposition of the arguments raised by appellants. Accordingly, we will adopt the examiner's reasoning, as stated in the Answer, as our own in sustaining the rejections of record, and we add the following for emphasis only.

Concerning the § 102/§ 103 rejection of claim 1 over Finberg, appellants contend that, whereas Finberg uses papaya leaves in addition to cabbage leaves in making a satisfactory chewing tobacco/snuff replacement, appellants' claimed composition "is 100% cabbage leaves" (page 2 of Reply Brief, second paragraph). However, the examiner properly explains that

the recitation of "comprising" in the first line of claim 1 "opens" the claim to ingredients other than those specifically recited, for instance, the papaya leaves of Finberg. The appealed claims encompass a composition that comprises a carrier consisting of 100% cabbage leaves and another carrier consisting of 100% papaya leaves. We note that appellants attempted to amend the claims accordingly after final rejection, but this amendment was not entered by the examiner.

Appellants also maintain that "Finberg teaches flavoring of cabbage leaves prior to grinding/shredding" (page 7 of principal brief, last paragraph). The examiner properly notes, however, that the appealed claims do not recite "any particular order of flavoring/grinding . . . [and] are drawn to a product, not a method" (page 10 of Answer, second paragraph).

Appellants also argue with respect to both § 102/§ 103 rejections that the references do not disclose the claim requirement that the cabbage leaves have at least 30% intact cell walls. However, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed

product. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In the present case, the examiner has set forth a rationale why it is reasonable to conclude that the cabbage leaves of Finberg and Aebi have at least 30% intact cell walls. Appellants, on the other hand, have failed to set forth any argument, let alone objective evidence, that the processing conditions of Finberg and Aebi would result in cabbage leaves having less than 30% intact cell walls. As has often been said, it is imminently fair to place such burden on an applicant inasmuch as the USPTO is not equipped to test the products of the prior art. While appellants may "bristle" at the conclusion reached by the examiner, such analysis is in accordance with current patent jurisprudence (page 8 of principal brief, last paragraph). We do not understand appellants' argument that nowhere does Aebi disclose that "the product should have anything less than 100% intact cell walls" (page 9 of principal brief, last full sentence), since 100% intact cell walls falls directly within the claimed range and, therefore, anticipates the range.

As for the claimed moisture content of at or below 8% by weight, the examiner points out that Finberg describes a water content of about 5% by weight, whereas Aebi describes a final

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product having a water content preferably in the range of 2-6% by weight.

Regarding the examiner's separate rejections under § 103, we refer to the Examiner's Answer. We observe that appellants base no argument upon objective evidence of nonobviousness to rebut the prima facie case of obviousness established by the examiner.

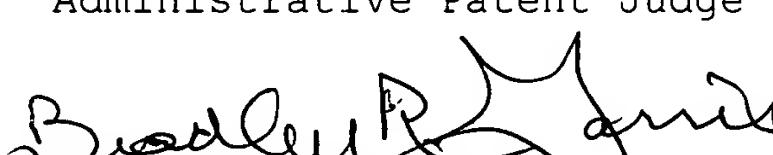
In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

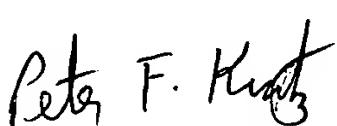
AFFIRMED


EDWARD C. KIMLIN

Administrative Patent Judge


BRADLEY R. GARRIS
Administrative Patent Judge

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PETER F. KRATZ
Administrative Patent Judge

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James C. Simmons
Ratner & Prestia
One Westlakes, Berwyn, Suite 301
P.O. Box 980
Valley Forge, PA 19482-0980

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